



PATENTS
15311-2107

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~~12/22/2004~~
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of:
Gilbert M. Wolrich et al.
Serial No.: 09/042,417
Filed: March 13, 1998
For: Reduction of Add-Pipe Logic by Op-
erand Offset Shift

)
Examiner: Firmin Backer
)
Art Unit: 2155
)

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DEC 27 2004
OFFICE OF PETITIONS

Cesari and McKenna, LLP
88 Black Falcon Avenue
Boston, MA 02210
December 17, 2004

CERTIFICATE OF MAILING

I hereby certify that the following Petition is being deposited with the United States Postal Service as first-class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 17, 2004.

Melissa Altman
Melissa Altman

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Applicants hereby request, pursuant to 37 C.F.R. §181, that the holding of abandonment in this application be withdrawn. As set forth herein, a Terminal Disclaimer was mailed by Applicants on May 28, 2004 in response to the Decision on Appeal, which

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had been mailed April 26, 2004. Although the Terminal Disclaimer was received by the Patent and Trademark Office, it was apparently never matched up with this application, as a Notice of Abandonment was issued on August 30, 2004.

In support of the present Petition, Applicants state as follows:

On April 26, 2004, a Decision on Appeal was mailed in this application. A true and correct copy of the Decision is attached hereto as Exhibit A. The Decision reversed the rejection of claims 1-7 based on 35 U.S.C. §102, but sustained the obviousness-type double patenting rejection of claims 1-7. In response to the Decision, Applicants filed a Terminal Disclaimer on May 28, 2004. Attached hereto as Exhibit B is a true and correct copy of the Terminal Disclaimer, the Certificate of Mailing and the return postcard, as filed by the Applicants on May 28, 2004.

The Terminal Disclaimer disclaimed the terminal part of any patent that might issue on the present application that would extend beyond the expiration date of U.S. Patent No. 6,018,756. Accordingly, the Terminal Disclaimer overcame the obviousness-type double patenting rejection that had been sustained by the Board of Patent Appeals and Interferences. As evidenced by the returned postcard, which bears a date stamp from OIPE, the Terminal Disclaimer was received by the Patent and Trademark Office on June 1, 2004. A true and correct copy of the returned postcard bearing the OIPE date stamp of June 1, 2004 is attached hereto as Exhibit C.

Apparently, however, the Terminal Disclaimer was never matched up with this application, because a Notice of Abandonment was issued on August 30, 2004. A true and correct copy of the Notice of Abandonment is attached hereto as Exhibit D. The Notice of Abandonment mistakenly states that no response to the Decision on Appeal was

ever submitted. To the contrary, as set forth above, a Terminal Disclaimer was in fact timely filed and received by the Patent and Trademark Office.

For the reasons set forth above, Applicants respectfully request that the Notice of Abandonment be withdrawn, and that the application be returned to the examiner for further consideration.

Revival of Application

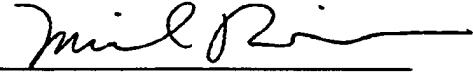
To the extent the foregoing is deemed insufficient to warrant a withdrawal of the Notice of Abandonment, Applicants hereby request that this application be revived pursuant to 37 C.F.R. §1.137(b). In this case, the required reply, i.e., the Terminal Disclaimer, is attached hereto at Exhibit B. Applicants, moreover, hereby state that the entire delay in filing the attached Terminal Disclaimer, from the due date to the date of this Petition, was unintentional.

For the reasons set forth above, Applicants alternatively request that the present application be revived and returned to the examiner for further consideration.

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15311-2107

Any fees required, including the Petition fee set forth at 37 C.F.R. §1.17(h) for a Petition to the Director and, alternatively, the Petition fee set forth at 37 C.F.R. §1.17(m) to revive an unintentionally abandoned application, are hereby authorized to be charged to Hewlett-Packard Company's deposit account no. 08-2025.

Respectfully submitted,


Michael R. Reinemann
Reg. No. 38,280
(617) 951-2500

Send all correspondence to:

IP Administration Legal Department,
M/S 35
Hewlett-Packard Co.
P.O. Box 272400
Fort Collins, CO 80527-2400

15:11.21

RAC/MT

The opinion in support of the decision being entered today was
not written for publication and is not binding precedent of the
Board.

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Paper No. 24

APR 29 2004

UNITED STATES PATENT AND TRADEMARK OFFICE
CESARI & MCKEEAN

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GILBERT M. WOLRICH, MARK D. MATSON
and JOHN D. CLOUSER

Appeal No. 2002-1805
Application 09/042,417

MAILED

APR 26 2004

ON BRIEF

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before JERRY SMITH, BARRETT, and LEVY, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

✓ DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from
the examiner's rejection of claims 1-7, which constitute all the
claims in the application.

NIA. Appeal Decision: Confirmed

The disclosed invention pertains to an addition pipeline for use in a floating point processor which speeds up the normalization of results obtained from floating point operations.

Representative claim 1 is reproduced as follows:

1. In a floating-point processor, an addition pipeline, adapted for application thereto of first and second operand signals, each of which represents the sign, exponent, and mantissa of a respective floating-point input operand, for performing an effective addition or subtraction on the input operands and generating an addition-pipeline output signal representing the result, the addition pipeline comprising:

- A) a main mantissa adder adapted for application thereto of first and second processed mantissa signals and representing respective mantissa values, the main mantissa adder being operable selectively to perform addition and subtraction on the mantissa values and generate a mantissa-adder output, representative thereof, from which the addition pipeline generates the addition-pipeline output; and
- B) mantissa-processing circuitry for so generating from respective ones of the input operands' mantissas and applying to the main mantissa adder respective processed mantissa signals that, for at least some pairs of mantissas, the mantissa signals applied to the main mantissa adder when the main mantissa adder is to subtract a pair of mantissas are offset to the left by one position from the mantissa signals applied thereto when the main mantissa adder is to add the same pair of mantissas.

The examiner relies on the following references:

Lynch	5,901,076	May 04, 1999
Wolrich et al. (Wolrich)	6,018,756	(filed Apr. 16, 1997) Jan. 25, 2000

Appeal No. 2002-1805
Application 09/042,417

Claims 1-7 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of Wolrich. Claims 1-7 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Lynch.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and double patenting relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the examiner's obviousness-type double patenting rejection is proper. We are also of the view that the disclosure of Lynch does not fully meet the invention as set forth in claims 1-7. Accordingly, we affirm.

Appeal No. 2002-1805
Application 09/042,417

Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 5]. Consistent with this indication appellants have made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 1 as representative of all the claims on appeal.

We will consider first the examiner's rejection of claims 1-7 as being anticipated by the disclosure of Lynch. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he finds the invention of representative claim 1 to be fully met by Lynch [answer, page 5]. Appellants argue that there is no suggestion in Lynch that the mantissas of the operands be shifted differently prior to a subtraction operation than prior to an addition. Appellants discuss each of the portions of Lynch referred to by the examiner and argue that none of these portions support the examiner's findings [brief, pages 5-7]. The examiner responds that appellants are arguing an inventive concept that does not appear in the disclosure. The examiner also maintains the position set forth in the rejection that Lynch fully meets the claimed invention [answer, pages 6-8]. Appellants respond that the claimed invention is consistent with the disclosure. Appellants also assert that the examiner is confusing alignment which takes place before an addition with normalization which takes place after an addition [reply brief].

We will not sustain this rejection for essentially the reasons noted by appellants in their briefs. As noted by appellants, Lynch shifts one of the operand mantissas with respect to the other operand mantissa to effect an exponent alignment of the mantissas before an addition or subtraction is performed. The amount of shifting performed by Lynch is exactly

Appeal No. 2002-1805
Application 09/042,417

the same whether the operation to be performed is an addition or a subtraction. Claim 1 recites that the mantissa signals are offset (shifted) by one position when they are to be subtracted from the position they would have if they are going to be added. Thus, claim 1 requires that the mantissas be treated differently for an addition operation than they would be treated for a subtraction operation. As noted above, Lynch discloses treating such mantissas the same regardless of the operation. Therefore, Lynch does not fully meet the invention as set forth in appellants' claims.

We now consider the obviousness-type double patenting rejection. The examiner notes that the claims on appeal are broader than the claims in the Wolrich patent. The examiner finds that these broader claims on appeal would have been obvious to the artisan over the patented claims of Wolrich [answer, pages 3-4]. Appellants respond that they propose to file a terminal disclaimer if the anticipation rejection is reversed [brief, page 5].

We will sustain this rejection. We agree with the examiner that the fact that the claims on appeal before us are broader than the claims of the Wolrich patent establishes a prima facie case of obviousness-type double patenting. Appellants offer to

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Application 09/042,417

file a terminal disclaimer does not overcome this rejection.

This rejection presumably will be withdrawn upon the filing of an appropriate terminal disclaimer.

In summary, we have sustained the obviousness-type double patenting rejection, but we have not sustained the anticipation rejection. Therefore, the decision of the examiner rejecting claims 1-7 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Jerry Smith

JERRY SMITH
Administrative Patent Judge

Lee E. Barrett

LEE E. BARRETT
Administrative Patent Judge

Stuart S. Levy

STUART S. LEVY
Administrative Patent Judge

)
) BOARD OF PATENT
)
) APPEALS AND
)
) INTERFERENCES
)

JS:pgc

Appeal No. 2002-1805
Application 09/042,417

Joseph H. Born
Cesari and McKenna
88 Black Falcon Avenue
Boston, MA 02210

Date Due: N/A
Date Mailed: May 28, 2004
Date Filed: March 13, 1998
Inventor(s): Gilbert M. Wohrich et al.
Title: Reduction of Add-Pipe Logic by Operand Offset Shift

File No.: 15311-2107
Serial No.: 09/042,417
Group Art Unit: 2155

Honorable Commissioner of Patents and Trademarks: We are sending herewith:

X Terminal Disclaimer Responsive to a Double
Patenting Rejection

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CESARI and McKENNA, LLP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of:)
Gilbert M. Wolrich et al.)
Serial No.: 09/042,417)
Filed: March 13, 1998)
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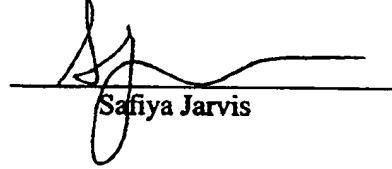
Examiner: Firmin Backer

Art Unit: 2155

Cesari and McKenna, LLP
88 Black Falcon Avenue
Boston, MA 02210
May 28, 2004

CERTIFICATE OF MAILING

I hereby certify that the following paper is being deposited with the United States Postal Service as first-class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 28, 2004.


Safiya Jarvis

Terminal Disclaimer Responsive to a Return Receipt Postcard
Double Patenting Rejection

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inv ntor(s): Gilbert M. Wolrich et al.

Confirmation No.:

Application No.: 09/042,417

Examiner: Firmin Backer

Filing Date: March 13, 1998

Group Art Unit: 2155

Title: REDUCTION OF ADD-PIPE LOGIC BY OPERAND OFFSET SHIFT

Commissioner for Patents
PO. Box 1450
Alexandria, VA 22313-1450

TERMINAL DISCLAIMER
RESPONSIVE TO A DOUBLE PATENTING REJECTION

Sir:

Petitioner, Hewlett-Packard Development Company, L.P. is the owner of 100 percent interest in the instant application. Petitioner hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer of prior Patent No. 6,018,756 to Hewlett-Packard Development Company, L.P. which issued on 01-25-2000 and is commonly owned by Petitioner. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, petitioner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

For submissions on behalf of an organization (e.g., corporation), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Please charge the required fee set forth in 37 CFR 1.20(d) of \$110.00 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

(Note: An attorney or agent of record must sign this document.)

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22313-1450. Date of Deposit: 05/28/2004

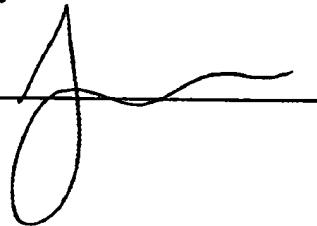
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Respectfully submitted,

Gilbert M. Wolrich et al.

By



Michael R. Reinemann

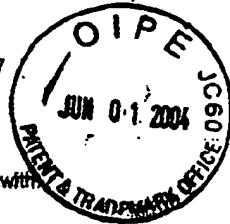
Attorney/Agent for Applicant(s)
Reg. No. 38,280

Date: 05/28/2004

Telephone No.: (617) 951-2500

Date Due: N/A
Date Mailed: May 28, 2004
Date Filed: March 13, 1998
Inventor(s): Gilbert M. Wolrich et al.
Title: Reduction of Add-Pipe Logic by Operand Offset Shift

File No.: 15311-2107
Serial No.: 09/042,417
Drawn Art Unit: 2155



Honorable Commissioner of Patents and Trademarks: We are sending herewith

Terminal Disclaimer Responsive to a Double
Patenting Rejection

Kindly have the mail room stamp this card and return it to us so that we may know that the above
mentioned papers were duly received.

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